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OFFICE OF PETITIONS

In re Application of
Robert H. Ellison, et al.
Application No. 10/699,075
Filed: October 31, 2003
Attorney Docket No. TS1326 USA

**DECISION ON PETITION
UNDER 37 CFR 1.78(a)(6)**

This is a decision on the petition under 37 CFR 1.78(a)(6), filed October 21, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application(s) set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT.**

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR 1.78(a)(6), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed application(s).

The instant pending Nonprovisional application was filed on October 31, 2003, and was pending at the time of the filing of the instant petition. While a reference to the prior-filed application(s) was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim

submitted elsewhere in the application within the time period set forth in 37 CFR 1.73(a)(5)(ii). However, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(6).¹ In the instant case, the Office noted the claim for priority of the prior-filed application(s) in the transmittal letter filed with the application, as shown by its (their) inclusion on the filing receipt.

In view of the above, the \$1330 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to Marianne Jenkins at (571) 272-3223. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to the Publishing Division to be processed into a patent.

Frances M. Hicks
Frances M. Hicks
Lead Petitions Examiner
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¹ Note MPEP 201.11(III)(D), pages 200-59 and 200-60 (Rev. 2. May 2004) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.